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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,562	10/18/2001	Daniel Damson	1720	2392
7590	01/06/2004			EXAMINER CIRIC, LJILJANA V
Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			ART UNIT 3753	PAPER NUMBER DATE MAILED: 01/06/2004 15

Please find below and/or attached an Office communication concerning this application or proceeding.

clo 15

Office Action Summary	Application No. 09/913,562	Applicant(s) Damson et al.
	Examiner Ljiljana V. Ciric <i>[Signature]</i>	Art Unit 3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Oct 9, 2003
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 7-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on Aug 12, 2003 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 9, 2003 has been entered.

Response to Amendment

2. This Office action is in response to the amendment and arguments filed on August 12, 2003, which are not
3. Claims 7 through 11 as amended remain in the application.

Response to Arguments

4. Applicant's arguments filed on Augsut 12, 2003 have been fully considered but they are not persuasive.

Contrary to applicant's assertion, the new claims, like the canceled original claims, are still generally narrative and indefinite, failing to conform with current U.S. practice as noted in greater detail below.

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As a preface to the following traversal of applicant's arguments, the examiner hereby notes that the claims in a pending application should be given their *broadest* reasonable interpretation. See In re Person, 181 USPQ 641 (CCPA 1974).

Applicant is also respectfully reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, “[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Applicant's arguments, some of which are not particularly clearly stated, appear to rely on the function or manner of operation of the apparatus for patentability, without clearly specifying how the structure of the claimed apparatus differs from that of the applied prior art.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the heat exchanger 7 “must have a sufficient drop or depression with reference to the general cooling circuit”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, the references listed on pages 1 and 2 of the specification do not constitute a proper information disclosure statement and have still not been considered by the examiner.

Drawings

6. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 12, 2003 have been disapproved because reference number 62 does not appear in the specification. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

7. In order to avoid abandonment, the drawing informalities noted in Paper No. 8, mailed on June 9, 2003, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

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Claim Rejections - 35 U.S.C. § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 7 through 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims STILL remain generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors. The claims comprise run-on limitations which are not readily comprehensible as written, and which are not clearly correlated to one another to allow one to understand exactly what is encompassed by the claims. It is not clear which portions of the claim constitute the preamble and which ones constitute the body of the claim, nor is it clear whether the claims are drawn to the subcombination of the heat exchanger only or to the heat exchanger and all associated elements of a particular vehicular system, thus rendering the metes and bounds of protection sought indefinite with regard to scope.

Claim Rejections - 35 U.S.C. § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. As best can be understood in view of the indefiniteness of claims, claims 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wulf*.

Wulf discloses the invention essentially as claimed, including: a heat exchanger 7 or a radiator 13 between a cooling circuit and an exhaust gas line 6 of an internal combustion engine 1, at least the heat exchanger 7 being disposed in the exhaust gas flow of the exhaust gas line 6, the heat exchanger 7 each having a coolant inflow 16 and a coolant return 17, as well as an exhaust gas inlet and an exhaust gas outlet respectively disposed at either end of exhaust gas chamber 8; a gas reservoir or overflow tank 18 connected at a high point of the coolant ducts 16 and 17; a thermostatic valve 11 is readable on the shut-off device as cited in claims 7 and 11 of the instant application, and on the first shut-off device as cited in claim 10 of the instant invention, the shut-off device being disposed between the coolant inflow lines 12 and 16; the piston of the internal combustion engine 1 is broadly readable as required on the second shut-off device as cited in claim 10 of the instant invention.

The reference thus reads on the claims.

Allowable Subject Matter

12. Claims 8 and 9 would be allowable if rewritten or amended, without significant broadening or other significant changes in scope, to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Conclusion

13. The following additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Cirim, whose telephone number is (703) 308-3925.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Cirim may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272.

The NEW central official fax phone number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

December 12, 2003


LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753